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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,558	09/17/2003	Michael Jared Ergo	EA-001C1	4597
25962	7590	01/10/2005	EXAMINER	
SLATER & MATSIL, L.L.P. 17950 PRESTON RD, SUITE 1000 DALLAS, TX 75252-5793			POND, ROBERT M	
			ART UNIT	PAPER NUMBER

3625

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/664,558

Applicant(s)

ERGO ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 22-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restriction***

During a telephone conversation with Mr. Barry Dove on 29 December 2004 a provisional election was made without traverse to prosecute the invention of Claims 1-21. Affirmation of this election must be made by the applicant in replying to this Office action. Claims 22-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Specification***

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. The Examiner notes the reference to Figure 3 on page 6 that does not exist. Please make the appropriate correction to reference Figures 3a and 3b.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2. Claims 1-3, 6-8, 10, 12, and 15-19 are rejected under 35 USC 103(a) as being unpatentable over Freeny, Jr. (patent number 4,528,643 hereinafter referred to as "Freeny"), in view of Spectradisc (a collection of prior art cited in PTO-892, Items: U, V, and UU), further in view of Official Notice (regarding well within the skill hereinafter referred to as "ON1").**

Freeny teaches a system and method for reproducing information in material objects at a point-of-sale location. Freeny teaches material objects as a medium or device in which information can be embodied or fixed and provided to a consumer at a point-of-sale location (e.g. video discs) (see at least abstract; col. 3, line 26 through col. 4, line 18; col. 5, lines 47-50). Freeny further teaches:

- *Receiving a request for the video:* consumer selects particular information to be reproduced (e.g. movie) at point-of-sale from local inventory or from a remote location (see at least col. 13, lines 14-24; col. 14, lines 56-63); request made at an intermediate location remote from the point of sale (see at least col. 27, lines 52-64).

- At a point of sale, writing video content on the optically readable medium:  
writes content at point-of-sale (e.g. movie, music) (see at least Fig. 1 (14); col. 3, lines 34-46; col. 4, lines 36-59; col. 4, line 60 through col. 5, line 50); requires authorization codes (see at least col. 5, lines 1-31).
- At the point of sale, providing the video on the optically readable medium to a customer: video recorded on video discs (see at least col. 5, lines 32-50).

Freeny teaches all the above as noted under the 103(a) rejection and teaches a) manufacturing material objects at a point-of-sale location, b) a consumer making selections using a catalog, c) a physically contained manufacturing apparatus at a point-of-sale location (please note examiner's interpretation: a kiosk) used to reproduce the consumer selections onto a recording medium (e.g. video disc), and c) piracy problems in the music and motion picture industry and reducing the incentive for piracy (see at least col. 3, lines 4-47), but does not teach at the point-of-sale, treating the optically readable medium with an opaquing layer, the opaquing layer designed to render the optically readable medium unreadable after a period of time. Spectradisc teaches limited-play DVDs that expire after a 48-hour period rental period. Spectradisc teaches SpectraDisc Corp. creating a limited-play DVD that uses environmentally safe chemistry to prevent the disc from playing after a pre-determined length of time (e.g. minutes to days). Spectradisc teaches the product positioned as a return-free alternative to

rental movies and games (U: see at least page 1). Spectradisc teaches coating the shiny side of the DVD (please note: an optical recording medium) with the special coating and creating a chemical reaction after the DVD package is opened, eventually turning the translucent coating blue that blocks the DVD player's ability to read the disk (please note examiner's interpretation: i) limited play time prevents unauthorized use once the disk is unreadable, and ii) once unreadable reduces piracy incentives) (V: see at least page 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Freeny to apply a coating via an apparatus to an optical recording medium that turns opaque after a pre-determine length of time as taught by Spectradisc, in order to prevent continued use of rented product beyond a pre-determined length of time, and thereby attract video information sources to the service who are looking for ways to reduce piracy incentives and/or to provide no-return rental products.

Freeny and Spectradisc teach all the above as noted under the 103(a) rejection and teach or suggest a) providing a more efficient, economical, and profitable method for reproducing a video disc with recorded information by pushing the information reproduction and final manufacture to the point of sale (see at least col. 4, lines 8-18), b) reducing piracy incentives and/or providing no-return rental products by applying a coating to a recorded DVD to limit play time, and c) the disc's duration being set during the last step of

the production process (UU: see at least page 1), but does not specifically disclose at the point of sale, treating the optically readable medium with an opaquing layer. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Freeny and Spectradisc to treat the optically readable medium with an opaquing layer at the point of sale, since it is well within the skill to ascertain that the point of sale location represents the last steps in the production process.

Pertaining to apparatus Claims 10, 12, and 15-19

Rejection of Claims 10, 12, and 15-19 is based on the same rationale as noted above.

- 3. Claims 4, 5, 13, and 14 are rejected under 35 USC 103(a) as being unpatentable over Freeny, Jr. (patent number 4,528,643), Spectradisc (a collection of prior art cited in PTO-892, Items: U, V, and UU), and ON1 (regarding well within the skill), as applied to Claims 3 and 12, further in view of Official Notice (regarding old and well known hereinafter referred to as "ON2").**

Freeny, Spectradisc, and ON1 teach all the above as noted under the 103(a) rejection and further teach a) a customer making a request at a point-of-sale, b) making a request from a location remote from the point of sale, and c) systems communicating over communication lines, but does not specifically disclose making a request using the Internet or a telephone. This examiner takes the

position that the use of the Internet or telephone to facilitate electronic commerce requests is notoriously well known in the arts. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Freeny, Spectradisc, and ON1 to disclose making a request using the Internet or a telephone, since it is notoriously well known that the Internet and the telephone facilitate electronic commerce, and thereby provide means by which requests are made by users.

- 4. Claim 9 is rejected under 35 USC 103(a) as being unpatentable over Freeny, Jr. (patent number 4,528,643), Spectradisc (a collection of prior art cited in PTO-892, Items: U, V, and UU), and ON1 (regarding well within the skill), as applied to Claim 1, further in view of Downs et al. (patent number 6,226,618 hereinafter referred to as "Downs").**

Freeny, Spectradisc, and ON1 teach all the above as noted under the 103(a) rejection and further teach a) reducing the amount of time to reproduce information on optically recordable medium, b) downloading content (e.g. movies) from a remote source, and c) providing the consumer with a rented video on a video disk, but do not disclose providing an estimated time for providing the rented video to the customer. Downs teaches a system and method of downloading electronic content (e.g. movies, music) to consumers, and further teaches providing a download progress indicator and an estimated time to completion (see at least abstract; col. 81, lines 59-61). Therefore it would have



been obvious to one of ordinary skill in the art at time of the invention to modify the method of Freeny, Spectradisc, and ON1 to provide an estimated time to completion as taught by Downs, in order to provide a consumer convenience, and thereby attract consumers to the service.

- 5. Claim 11 is rejected under 35 USC 103(a) as being unpatentable over Freeny, Jr. (patent number 4,528,643), Spectradisc (a collection of prior art cited in PTO-892, Items: U, V, and UU), and ON1 (regarding well within the skill), as applied to Claim 10, further in view of Official Notice (regarding notoriously well known hereinafter referred to as "ON3").**

Freeny, Spectradisc, and ON1 teach all the above as noted under the 103(a) rejection and teach a point-of-sale computer-based kiosk used to produce rented products produced on optically recordable medium, but do not disclose specifics about kiosk computing components. This examiner takes the position that the use of touch screen monitors, keyboards, and pointing devices to provide user input to a computer are notoriously well known. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Freeny, Spectradisc, and ON1 to provide a group of input devices as taught by ON3, in order to provide user inputs, and thereby provide a user convenience.

- 6. Claim 20 is rejected under 35 USC 103(a) as being unpatentable over Freeny, Jr. (patent number 4,528,643), Spectradisc (a collection of prior art cited in PTO-892, Items: U, V, and UU), and ON1 (regarding well within the skill), as applied to Claim 19, further in view of Official Notice (regarding notoriously well known hereinafter referred to as "ON4").**

Freeny, Spectradisc, and ON1 teach all the above as noted under the 103(a) rejection and teach a point-of-sale computer-based kiosk used to produce rented products produced on optically recordable medium, but do not disclose displaying advertisements. This examiner takes the position that the use of consumer kiosks to display advertisements is notoriously well known in the arts. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify Freeny, Spectradisc, and ON1 to have the consumer kiosks display advertisements as taught by ON4, in order to advertise rented movies, and thereby attract consumers to the service.

- 7. Claim 20 is rejected under 35 USC 103(a) as being unpatentable over Freeny, Jr. (patent number 4,528,643), Spectradisc (a collection of prior art cited in PTO-892, Items: U, V, and UU), and ON1 (regarding well within the skill), as applied to Claim 10, further in view of Cook (patent number 5,860,068).**

Freeny, Spectradisc, and ON1 teach all the above as noted under the 103(a) rejection and teach a point of sale computer-based kiosk used to produce rented

products produced on optically recordable medium, but do not disclose dispensing a gift card. Cook teaches a system and method for selling, manufacturing and distributing custom digital data in retail stores, the management server providing advertisements, and further teaches dispensing gift cards purchased by consumers at any publicly accessible location (e.g. retail kiosk, retail establishment) and using the gift card for third-party purchases (see at least abstract; Fig. 1 (22); col. 5, lines 21-34). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify Freeny, Spectradisc, and ON1 to dispense gift cards from a retail kiosk as taught by Cook, in order to provide a shopping incentive, and thereby attract third-party consumers to the service.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Digital On-Demand: Bannan, Karen; "Appearing Soon at Store Near You: An A.T.M. for the Ears," New York Times, 20 April 2000, pgG.7, Proquest #52762868, 3pgs. Teaches Digital On-Demand providing consumer kiosks in retail stores and reproducing downloaded music on blank CDs.
- Digital On-Demand: Goldstein, Seth; "Video Distribution Ready to Test Downloading Movies to Stores," Video Store Magazine, 12-18 March 2000, v22n11pg8, Proquest #51033155, 2pgs. Teaches Digital On-Demand testing movie downloads to retail stores.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Art Unit: 3625

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**703-872-9306** (Official communications; including After Final

communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



Robert M. Pond  
Primary Patent Examiner  
January 5, 2005